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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,960	11/27/2001	Koji Tokunaga	15124	1702

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EXAMINER

PHUONG, DAI

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/994,960

Applicant(s)

TOKUNAGA, KOJI

Examiner

Dai A. Phuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 01/18/2007 have been fully considered but they are not persuasive. Claims 1-3 are currently pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because claim 1 recites "a plurality of memories, each of which is for endless-recording." It should be noted that a memory is contained a number of bytes or the memory is not able to store an unlimited of data (endless recording). Therefore, the memory is not able to be an endless-recording memory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanpei et al. (U.S. 5732349) in view of Minakata et al. (U.S. 6658496) and further in view of Qua et al. (U.S. 6222909).

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Regarding claim 1, Sanpei et al. disclose a portable phone having a recording function for recording audio data during telephone conversation (fig. 3, col. 5, lines 1-14), said portable phone comprising: a memory 24 which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 3, col. 5, lines 1-14).

However, Sanpei et al. do not disclose a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endless-records before being switched by said switching unit, while the second memory endless-records the current conversation simultaneously with the reproducing of the conversation content from the said first memory.

In the same field of endeavor, Minakata et al. disclose a plurality of memories 9a and 9b, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation (fig. 1, col. 2 lines 53-67); a switching unit 50 capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio data instead of said first memory which endless-records, as the conversation content, the audio data until said

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switching unit switches said memories from said first memory to said second memory (col. 3, lines 32-51); and a reproducing unit 20 for reproducing the conversation content which said first memory endlessly-records before being switched by said switching unit, while the second memory endlessly-records the current conversation (fig. 1, col. 4, line 47 to col. 5, line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone of Sanpei et al. by specifically including a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endlessly-records the audio data instead of said first memory which endlessly-records, as the conversation content, the audio data until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endlessly-records before being switched by said switching unit, while the second memory endlessly-records the current conversation., as taught by Minakata et al., the motivation being in order to provide a recording/reproducing apparatus in which it is possible to improve tractability of a recording/reproducing apparatus having plural storage units, such as removable storage units, and to facilitate the operation of transfer processing for data stored in a storage unit of the recording/reproducing apparatus.

In the same field of endeavor, Qua et al. disclose a reproducing unit for reproducing the conversation content which said memory endlessly-records before being switched by said switching unit, while the memory endlessly-records the current

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conversation simultaneously with the reproducing of the conversation content from the said first memory (col. 1, lines 40-49 and col. 6, line 39 to col. 8, line 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone of Sanpei et al. by specifically including a reproducing unit for reproducing the conversation content which said memory endlessly-records before being switched by said switching unit, while the memory endlessly-records the current conversation simultaneously with the reproducing of the conversation content from the said first memory, as taught by Qua et al., the motivation being in order to distribute the stored information to oneself or other parties once the information has been recorded. On the other hand, it provides a user ability to take accurate note while engaged in a conversation, since the user may simultaneously be engaged in another task.

Regarding claim 2, the combination of Sanpei et al. and Minakata et al. and Qua et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone wherein said memories are constituted by a plurality of memory areas of a single memory device, said memory areas being capable of individually endlessly-recording the audio data (col. 5, lines 64 to col. 6, line 12).

Regarding claim 3, the combination of Sanpei et al. and Minakata et al. and Qua et al. disclose all the limitations in claim 1. Further, Minakata et al. disclose a portable phone further comprising a key for operating said reproducing unit to reproduce the audio data; said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents (fig. 1, col. 4, line 47 to col. 5, line 11).

Response to Argument

5. Applicant, on page 4 of his response, argues that the Examiner has rejected claims 1-3 under 35 U.S.C. § 101 because claim 1 recites "a plurality of memories, each of which is for endless-recording" but memory is not able to store an unlimited amount of data. Applicant agrees that the amount of data stored in memory is not unlimited. However, "endless-recording" as defined in the specification on page 7, lines 14-17, means the conversation continues to be recorded, without stopping, until the conversation ends or a switch to another memory occurs. In the case where the memory is full, its contents are replaced, by recording new data over previously recorded data of the current conversation in that same memory. However, the Examiner respectfully disagrees.

First, it is noted that the features upon which applicant relies (i.e., the conversation continues to be recorded, without stopping, until the conversation ends or a switch to another memory occurs. In the case where the memory is full, its contents are replaced, by recording new data over previously recorded data of the current conversation in that same memory) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, the Applicant used a particular words recited in the claim, e.g. "endless-recording". During patent examination, the pending claims must be given their broadest reasonable interpretation. In *re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once

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issued, will be interpreted more broadly than is justified. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 51 (CCPA 1969). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In *re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). See MPEP 2111. Therefore, the Examiner interpreted "a memory is for endless-recording" as a regular memory. So that, the language used by Applicant is broad enough as explained in previous Advisory Action (mailed 10/18/2006).

6. Applicant, on page 6 and 7 of his response, argues that the portable phone disclosed by Sanpei includes a memory. However, Sanpei and Minakata do not teach or suggest that the memory is for endless-recording and Sanpei does not teach a memory or memory areas as recited in applicant's claims 1 and 2. The Examiner respectfully disagrees. The Examiner interpreted "a memory is for endless-recording" as a regular memory. Please see above explanation.

7. Applicant, on page 8 of his response, argues that Minakata does not disclose or suggest switching recording from a first memory to a second memory to playback a portion of a current conversation from that first memory while simultaneously recording the remainder of that current conversation in the second memory. Thus, Minakata does not disclose or suggest "a reproducing unit for reproducing the conversation content which said first memory endless recorded before being switched by said switching unit, while the second memory endless records the audio data of the current conversation simultaneously with the reproducing of the conversation content from said first memory" as recited in claim 1. However, the Examiner respectfully disagrees.

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First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., playback a portion of a current conversation from that first memory while simultaneously recording the remainder of that current conversation in the second memory) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third, Minakata discloses in column 2, lines 54 to 67 that the recording/reproducing apparatus according to the present invention (termed simply an IC recorder) includes a flash memory 9, first flash memory 9a and second flash memory 9b, which is an electrically erasable/programmable read-only memory (EEPROM) allowing for electrical data erasure/rewriting by a recording unit 10, a controller 30 for performing control to write speech data in the flash memory 9 and to reproduce speech data read out from the flash memory 9 by a reproducing unit 20, and a display unit 40 for displaying the actuation contents from an actuating unit 50 and the speech data contents stored in the flash memory 9. The flash memory 9, used herein, includes a first flash memory 9a nondetachably enclosed in the IC recorder 1 and a second flash memory 9b detachable from the IC recorder 1.

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8. Applicant, on page 8 of his response, argues that Qua does not teach a plurality of memories, as recited in claim 1 of the present application. In addition, Qua teaches only a single storage device and no switching unit, so that simultaneous recording of audio information while retrieval and playback of the previously recorded information occurs is impossible. However, the Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9. Applicant, on page 10 of his response, argues that neither Sanpei nor Minakata nor Qua, taking singly or in any proper combination, teach or suggest all of the features of independent claim 1. However, the Examiner respectfully disagrees. Since, Minakata discloses that if such a telephone handset is available by which task files can be stored in the second flash memory 9b or by which task files recorded in the second flash memory 9b or other flash memories, the contents of the telephone call can be stored in the second flash memory 9b, and the second flash memory 9b can be detached from the second flash memory 9b and loaded on the IC recorder 1 to hear the contents of the telephone conversation stored in the second flash memory 9b. Conversely, the second flash memory 9b can be detached from the IC recorder 1 and loaded on the aforementioned telephone handset to reproduce the task files recorded in the second flash memory 9b for hearing by the counterpart of telephone conversations. On the other hand, Qua discloses a system and method that permit a user to record audio information, i.e., audio notes, during a conversation on any telephonic communications device, e.g., wireless or wired devices,

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coupled to an appropriate network, and distribute the information to other parties in a number of different formats. For that reason, the examiner contends that Minakata and Qua are properly combined with Sanpei.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

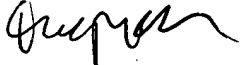
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen M Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7503.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong
AU: 2617
Date: 03-29-2007


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